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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,958	06/29/2001	Xuelu Zou	024705-110	6091

7590

07/15/2003

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EXAMINER

BOLDEN, ELIZABETH A

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/893,958

Applicant(s)

ZOU ET AL.

Examiner

Elizabeth A. Bolden

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 11, 12, 17-19, 59-63 and 65-110 is/are pending in the application.
- 4a) Of the above claim(s) 102-104 and 107 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 11, 12, 17-19, 59-63, 70-101, 105 and 108-110 is/are rejected.
- 7) ☒ Claim(s) 66-69 and 110 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn.

#### ***Claim Objections***

Claim 110 is objected to because of the following informalities: typographical error.

In line 2 of claim 110 "ore" should be corrected to read "or".

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 11, 12, 17-19, 59-63, 65, 70-101, 105, 106, and 108-110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi et al., U.S. Patent 4,115,131.

Ishibashi et al. teach an optical glass in terms of weight percent. See column 1, lines 47-53, column 7, line 4 to column 8, line 16. Ishibashi et al. teach a glass having overlapping ranges of refractive index and Abbe number with instant claims 1-3 and 74-77. See abstract.

Ishibashi et al. differs from the instant claims by not teaching the glass composition in terms of mole percent.

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It is believed that Ishibashi et al. teach a composition whose ranges if converted from wt% to mol % would overlap the compositional limitations of claims 11, 12, 17-19, 59-63, 65, 70-101, 105, 106, and 108-110 and theoretical composition below. See column 1, lines 47-53 and column 7, line 4 to column 8, line 16. Overlapping ranges have been held to establish *prima facie* obviousness. MPEP 2144.05

	B <sub>2</sub> O <sub>3</sub>	P <sub>2</sub> O <sub>5</sub>	GeO <sub>2</sub>	Li <sub>2</sub> O	Na <sub>2</sub> O	K <sub>2</sub> O	SrO	BaO	ZnO	TiO <sub>2</sub>	Nb <sub>2</sub> O <sub>5</sub>	WO <sub>3</sub>
Wt %	4.0	20.0	1.0	4.0	7.0	2.0	2.0	6.0	5.0	5.0	28.0	16.0
Mol %	6.9	16.9	1.2	16.0	13.6	2.6	2.3	4.7	7.4	7.5	12.7	8.3

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected from the overlapping portion of the ranges disclosed by the reference because overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

One of ordinary skill in the art would expect that a glass with overlapping compositional ranges would have the properties recited in claims 1-3, 61-63, 70-73, and 78-81.

#### ***Allowable Subject Matter***

Claims 66-69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:  
The further limitation wherein the glass comprises no GeO<sub>2</sub> renders these claims allowable.

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***Response to Arguments***

Applicant's arguments with respect to claims 1-3, 11, 12, 17-19, 59-63, 65, 70-101, 105, 106, and 108-110 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Bolden whose telephone number is 703-305-0124. The examiner can normally be reached on 8:30am to 6:00 pm with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 703-308-3823. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

EAB  
July 9, 2003

  
**DAVID SAMPLE**  
**PRIMARY EXAMINER**